

IBOOKSTORE (SN 85/008,432) – office action response

Section 2(e)(1)

The Examining Attorney has refused registration under Section 2(e)(1) of the Trademark Act, taking the position that IBOOKSTORE is merely descriptive of the services covered by the application. Applicant Apple Inc. (“Apple”) has amended its application to add a claim of acquired distinctiveness under Section 2(f) of the Trademark Act.

Apple uses IBOOKSTORE as its service mark for providing more than 1.5 million books and other content that can be accessed on Apple’s iPhone, iPad, and iPod touch devices, using Apple’s free IBOOKS interactive e-reader software application.

Apple already owns registrations of IBOOKS and IBOOK on the Principal Register, for the following goods:

- IBOOKS (RN 2,446,634), registered in 2001, for “computer software used to support and create interactive, user-modifiable electronic books.”
- IBOOK (RN 2,470,147), registered in 2001, for “computer hardware.”

See **Exhibit A**. Both marks were registered as inherently distinctive, without a claim of acquired distinctiveness.

Even if the Examining Attorney takes the position that Apple’s registrations of IBOOKS and IBOOK are insufficient to demonstrate that IBOOKSTORE is inherently distinctive, there is ample evidence that the mark has acquired distinctiveness and is registrable under Section 2(f).

IBOOKSTORE is a member of Apple’s family of famous marks that begin with the prefix “i”, and a direct descendant of one of the original marks in this family, the IBOOK mark, used for almost a decade for Apple’s laptop computers. Apple first developed this family of marks in 1998, with the launch of its groundbreaking IMAC desktop computer. The IBOOK laptop followed in 1999, as did the IMOVIE software. This family significantly expanded in 2001 with the launch of the IPOD digital media player and the ITUNES digital music management software. Apple also introduced its IDVD software in 2001. Its ICAL and IPHOTO software products came to market in 2002. The ILIFE, ISIGHT and ICHAT software products followed in 2003. In 2003, Apple also launched the iTunes Store, originally a service that allowed customers to find, purchase and download third-party digital music. The service has been expanded to include audio books, music videos, short films, television shows, movies, podcasts, games, and other applications. In 2007, Apple introduced its now-famous IPHONE digital mobile device. In 2010, Apple introduced another landmark product under an “i”-formative mark, the

IPAD digital electronic device, and introduced its ICLOUD cloud computing software and services in 2011. Apple now holds more than 100 active federal applications and registrations of marks that begin with the prefix “i.”

The IBOOK laptop, the IPOD media player, the ITUNES software and ITUNES STORE service, the IPHONE digital mobile device, and the IPAD tablet device have all been particularly influential in cementing the public perception that the “i”-prefix brand is synonymous with Apple. The remarkable success of each of these products, and the fact that Apple’s IBOOKSTORE service operates in the same Apple product environment as these devices, guarantee that Apple’s IBOOKSTORE is immediately perceived as part of the same family of marks. As documented in Apple’s response to the suspension inquiry on this application, and as shown in the figures in **Exhibit B**:

- The groundbreaking iBook laptop was the first mainstream computer with integrated wireless networking and, in tandem with the iMac desktop, clearly established Apple’s identification with “i”-prefix branding.
- Apple has sold more than 350 million iPod devices since the product’s introduction. Apple owns nearly two dozen active federal trademark registrations and applications that incorporate the IPOD mark.
- Through its iTunes Store, Apple has sold over 25 billion songs. In 2008, the iTunes Store surpassed Wal-Mart to become the largest music retailer in the United States. iTunes is now the world’s most popular online music, TV and movie retailer, featuring a catalog of over 26 million songs, over 190,000 TV episodes and over 45,000 movies. Apple owns approximately 20 active federal trademark registrations and applications for marks that include ITUNES.
- The announcement of the iPhone generated unprecedented publicity in 2007, and Apple sold 1 million units of the device in less than 3 months. Subsequent versions of the iPhone fared even better—the iPhone 3G (released July 2008) sold 1 million units in the first weekend it was on sale; the first-weekend sales of iPhone 4 (released June 2010) were more than 50% higher, reaching 1.7 million units; and pre-orders of the iPhone 4S (released October 2011) topped 1 million in the first 24 hours. In September 2012, Apple launched the iPhone 5, and had sold 5 million units of the device just three days after the product’s launch. *Fortune* magazine has marveled that the iPhone is “one of the most successful products in business history.” As of June 2012, Apple had sold more than 250 million iPhone devices worldwide. Apple owns approximately 20 active federal trademark registrations and applications for marks that incorporate IPHONE.
- Apple sold 300,000 units of the iPad tablet device in the first day, and had sold 1 million units before the end of the first month, 2 million units before the end of the second month, and 3 million in the first 90 days. As of October 2012, total sales

had topped 100 million. Apple and its affiliates own 12 active federal trademark registrations and applications for marks that incorporate the IPAD mark.

More recently, Apple launched two new “i”-prefix marks to great success and consumer acceptance:

- Apple launched its ICLOUD cloud computing service in October 2011. As of July 2012—a mere nine months after the service was launched—more than 150 million consumers use the software and services. See **Exhibit C**. Apple owns a dozen active federal trademark registrations and applications for marks that incorporate the ICLOUD mark. See **Exhibit D**.
- Apple also launched its IMESSAGE software and service in October 2011. By June 2012, over 140 million people were using the IMESSAGE software and service, and had sent over 150 billion messages through the IMESSAGE software, at a rate of approximately 1 billion messages a day. See **Exhibit E**.

Given the success of these other “i”-prefix brands, consumers immediately recognize IBOOKSTORE as Apple’s mark, not a descriptive or generic term.

Apple’s IBOOKSTORE service is now available in 51 countries, and the IBOOKS application has been downloaded 130 million times.

The Examining Attorney has cited six web pages on which “ibookstore” is purportedly used as a generic abbreviation for “Internet bookstore.” However, a handful of web pages are not sufficient to demonstrate how the average consumer perceives a term. There is no evidence that these web pages all represent current-day usage, that they are all from U.S. sources, or that they have any measurable readership that would reflect or impact consumer perception of the term. In fact, none of the cited references to “ibookstore” appears in a mainstream publication. In addition, the Examining Attorney has cited three references to the phrase “Internet bookstore”—including by *The New York Times* (in 1997) and the Associated Press (in 2010)—but none of those cited references use the term “ibookstore.”

In fact, authoritative sources such as the *Computer Desktop Encyclopedia* and the *PC Magazine Encyclopedia* show that “ebookstore” is the generic term for retailing electronic books. These sources include no entry for IBOOKSTORE except for references to Apple’s brand. Similarly, other parties such as Google and Barnes & Noble have used “ebook store” or “ebookstore”—not “ibookstore”—to identify their websites for downloading electronic books. This generic usage of “ebookstore” is consistent with the fact that “ebooks” is understood as a generic term. See **Exhibit F**. By contrast, the registered mark IBOOKS is widely recognized as Apple’s brand, and consumers recognize IBOOKSTORE as an extension of that brand.

In summary, even if one accepts the premise that IBOOKSTORE could be descriptive with respect to the services covered by this application, Apple's mark has unquestionably achieved distinctiveness. Apple's application to register IBOOKS for the software used with the IBOOKSTORE service (SN 85/008,412) has been allowed for registration under Section 2(f). The same evidence of acquired distinctiveness supports the registrability of IBOOKSTORE. Given that Apple's IBOOKSTORE service is provided to users of Apple's IBOOKS software, consumers familiar with the IBOOKS brand immediately recognize IBOOKSTORE as a member of the same family of marks. Therefore, Apple respectfully requests that the Examining Attorney withdraw the Section 2(e)(1) refusal and approve the application for publication.

Specimen in Class 41

The Examining Attorney has declined to accept Apple's specimen in Class 41 on the grounds that it does not show use of the mark in connection with services featuring online non-downloadable publications. However, the specimen specifically states the following: "Read a free sample of any book on the iBookstore before making it part of your collection." The free sample described in the specimen is non-downloadable, and is provided online. Thus, the specimen supports use of the mark for Apple's identification in Class 41, namely, "providing online, non-downloadable electronic books...." Accordingly, Apple respectfully requests that the Examining Attorney withdraw the requirement for a substitute specimen.